

REMARKS

Claims 1-14 and 16-22 were examined and reported in the Office Action. Claims 1-14 and 16-22 are rejected. Claims 1, 6, 13 and 18 are amended. New claims 23-30 are added. Claims 1-14 and 16-30 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 112

It is asserted in the Office Action that claims 1, 6, 13 and 18 are rejected under 35 U.S.C. § 112, as failing to comply with the written description requirement. Applicant has amended claims 1, 6, 13 and 18 to overcome the 35 U.S.C. § 112 rejections. Applicant notes that the amendments are supported in the original specification at page 5, paragraph [0017].

Accordingly, withdrawal of the 35 U.S.C. § 112 rejections for claims 1, 6, 13 and 18 are respectfully requested.

II. 35 U.S.C. § 103(a)

It is asserted in the Office Action that claims 1-14 and 16-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng, U.S. Patent Application Publication No. 2002/0078161 ("Cheng") in view of Moyer et al., U.S. Patent Application Publication No. 2002/0103898 ("Moyer"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

be found in the prior art, and not based on applicant's disclosure.
(In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant’s amended claim 1 contains the limitations of

an electronic device for coupling to a home network system, the electronic device having a memory device, the memory device contains a remote location’s complete address to a page storing one of control and characteristic information for the electronic device, one of the control and the characteristic information is retrieved from the remote location if the home network system does not have the one of control and the characteristic information stored, the electronic device achieves plug-n-play operability without using a protocol.

Applicant’s amended claim 6 contains the limitations of

a plurality of electronic devices each including a memory device, each of the memory devices contain a remote location’s complete address to a page storing one of control and characteristic information for each electronic device, one of the control and the characteristic information is retrieved from the remote location if a home network system does not have the one of control and the characteristic information stored; a plurality of device specific buses coupled specifically to the plurality of electronic devices; a plurality of device specific network bridge devices coupled specifically to the plurality of device specific buses and the home network; and a device for communicating with a remote network, wherein each of the electronic devices achieve plug-n-play operability without using a protocol.

Applicant's amended claim 13 contains the limitations of

generating a request for a device's remote location complete address to a page storing one of control and characteristic information for the device; receiving the requested device's complete address from the device; determining whether characteristic information for the device is previously stored on a home network system; communicating with the remote location if the device's characteristic information is not previously stored on the home network system; retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the home network system; controlling the device on the home network system, wherein the device achieves plug-n-play operability without using a UPnP.

Applicant's amended claim 18 contains the limitations of

generating a request for a device's remote location complete address to a page storing one of control and characteristic information for the device; receiving the requested device's complete address; determining whether characteristic information for the device is previously stored on a home network system; communicating with the remote location if the device's characteristic information is not previously stored on the home network system; retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system; storing the characteristic information not previously stored on the system; and controlling the device on the home network system, wherein the device achieves plug-n-play operability without using a protocol.

Cheng discloses a UPnP controller 120 that uses the UPnP protocol to communicate with UPnP enabling device 200. UPnP enabling device 200 includes an IP network interface that receives commands and requests from the UPnP controller 120 using UPnP protocol and slave network interfaces, and transforms the UPnP protocol to device and network specific commands and requests. "These device and network specific commands and requests are communicated to the controlled non-UPnP device, via the slave network, using the slave network's protocol." (Cheng, Abstract). The UPnP enabling device 200 also includes "enabling logic to support the UPnP addressing, discovery, and description processes for each of the devices on the non-IP network. (*Id.*) In other words, the UPnP enabling device 200 acts as an emulator by translating

UPnP protocol and non-UPnP protocol to one another. Therefore, Cheng does not teach, disclose or suggest “the electronic device achieves plug-n-play operability without using a protocol,” “each of the electronic devices achieve plug-n-play operability without using a protocol,” nor “the device achieves plug-n-play operability without using a protocol.”

Moyer discloses using a Session Initiated Protocol (SIP) to communicate with Network-capable appliances. Moyer further discloses “[a]n example of this new MIME type is the Device Messaging Protocol (DMP). DMP is an XML-based specification similar to Universal Plug 'n Play's Device Control Protocol.” (Moyer, page 4, paragraph [0051]). Therefore, Moyer does not teach, disclose or suggest “the electronic device achieves plug-n-play operability without using a protocol,” “each of the electronic devices achieve plug-n-play operability without using a protocol,” nor “the device achieves plug-n-play operability without using a protocol.”

Therefore, even if Cheng were combined with Moyer, the resulting invention would still not include all of Applicant's claimed limitations. And, therefore, there would be no motivation to combine Cheng with Moyer. Moreover, by viewing the disclosures of Cheng and Moyer, one can not jump to the conclusion of obviousness without impermissible hindsight. According to MPEP 2142,

[t]o reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the ‘differences,’ conduct the search and evaluate the ‘subject matter as a whole’ of the invention. The tendency to resort to ‘hindsight’ based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicant submits that without first reviewing Applicant's disclosure, no thought, whatsoever, would have been made to “the electronic device achieves plug-n-play operability

without using a protocol,” “each of the electronic devices achieve plug-n-play operability without using a protocol,” nor “the device achieves plug-n-play operability without using a protocol.”

Since neither Cheng, Moyer, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claims 1, 6, 13 and 18, as listed above, Applicant's amended claims 1, 6, 13 and 18 are not obvious over Cheng in view of Moyer since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1, 6, 13 and 18, namely claims 2-5, 7-12, 14 and 16-17, and 19-22, respectively, would also not be obvious over Cheng in view of Moyer for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1-14 and 16-22 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-14 and 16-30 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on February 14, 2006


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